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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,668	07/01/2003	Simon Jones	8702.0018-08000	3471

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EXAMINER

SZPERKA, MICHAEL EDWARD

ART UNIT PAPER NUMBER

1644

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/612,668

Applicant(s)

JONES ET AL.

Examiner

Michael Szperka

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29-55 is/are pending in the application.
- 4a) Of the above claim(s) 48-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/17/03</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 29-55 are pending in the instant application.

Applicant's election of Group I, claims 29-47, drawn to antibodies that specifically bind human calcium independent cytosolic phospholipase A<sub>2</sub>/B, and the species election of SEQ ID NO:19 (SEQ ID NO:18), in the reply filed on December 1, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 48-55 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

The examination of Group I has been extended beyond the elected species of SEQ ID NO:19 (SEQ ID NO:18) to include all of the species.

2. Applicant is reminded to update the current status of all applications identified in the specification, especially those from which priority is claimed under 35 USC 120 in the first line of the specification.

Applicant's preliminary amendment dated July 1, 2003, updates some of the priority data contained in the first line of the specification. However, this amendment to the first line of the specification does not indicate that application 09/927,180 is now US Patent No. 6,645,736, or reference PCT/US95/08069. Priority to PCT/US95/08069 is claimed under 35 USC 119 in the declaration and power of attorney filed July 1, 2003. PCT/US95/08069 appears to be a continuation of US 08/281,193, now US Patent No. 5,466,595. Applicant should amend the first line of the specification to claim priority to PCT/US95/08069 and indicate that application 09/927,180 is now US Patent No. 6,645,736.

It is noted that Applicant has amended the title of the instant application to read "Antibodies to calcium independent cytosolic phospholipase A<sub>2</sub>/B enzymes." However, the abstract of the application makes no reference to antibodies. Addition of such language to the abstract would be appropriate.

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 29-47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the currently recited antibodies are products of nature. This is because the sequences to which the antibodies specifically bind are found in nature, and as such antibodies that specifically bind these sequences would also be a product of nature. Amendment of the claims to recite "an isolated and purified antibody..." would remove this rejection.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 44-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Base claim 44 recites an antibody that binds to a polypeptide encoded by nucleic acid sequences, two of which are the DNA insert of the plasmid deposited with ATCC as accession number 69948 and the DNA insert of the plasmid deposited with ATCC as accession number 69949. It appears that these materials are essential to practice the

claimed invention. The specification does not indicate that these materials were deposited under the terms of the Budapest treaty and that they will be irrevocably and without restriction or condition released to the public upon the issuance of a patent.

If the deposit has been made under the terms of the Budapest Treaty, an affidavit or declaration by applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his or her signature, stating that ATCC 69948 and ATCC 69949 have been deposited under the Budapest Treaty and that ATCC 69948 and ATCC 69949 will be irrevocably and without restriction or condition released to the public upon the issuance of a patent would satisfy the deposit requirement made herein. See 37 CFR 1.808. Further, the record must be clear that the deposit will be maintained in a public depository for a period of 30 years after the date of deposit or 5 years after the last request for a sample or for the enforceable life of the patent, whichever is longer. See 37 CFR 1.806 and MPEP 2410-2410.01. If the deposit has not been made under the Budapest treaty, then an affidavit or declaration by applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his or her signature must be made, stating that the deposit has been made at an acceptable depository and that the criteria set forth in 37 CFR 1.801-1.809, have been met.

If the deposit was made after the effective filing date of the application for a patent in the United States, a verified statement is required from a person in a position to corroborate that the vector described in the specification as filed are the same as that

deposited in the depository. Corroboration may take the form of a showing of a chain of custody from applicant to the depository coupled with corroboration that the deposit is identical to the biological material described in the specification and in the applicant's possession at the time the application was filed.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 29-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) Claims 29-31, 33, 35, and 37-39 recite "a polypeptide having" or "the polypeptide has" a certain amino acid sequence. The use of "having" or "has" in relation to a sequence makes the scope of the claims uncertain. If applicant intends "having" and "has" to indicate a closed sequence, the phrase "consisting of" should be recited. Alternatively, if "has" and "having" are intended to indicate an open sequence, the phrase "comprising" should be used. Appropriate amendment of the claims is suggested.

B) Claims 29-47 recite an antibody that binds a sequence. All antibodies are capable of both specific and non-specific binding to antigens due to cross-reactivity. Amendment of the base claims to recite "An antibody that specifically binds..." would obviate this rejection.


8. No claims are allowable.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Szperka whose telephone number is 571-272-2934. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571-272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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January 4, 2005

  
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